

Appl. N . 09/691,308  
Amdt. dated May 24, 2004  
Reply to Office action of March 30, 2004

### **REMARKS**

This is in response to the Office Action mailed March 30, 2004. In the Office Action, Applicants' Claims 1-31 were rejected as obvious in view of the combination of U.S. Pat. No. 6,253,151 ("Ohler") and U.S. Pat. No. 5,864,632 ("Ogawa"). Applicants respectfully request reconsideration of the present application. Applicants submit that Claims 1-31 are not obvious over the cited references as explained below.

#### **Claims 1-31**

Applicants' Claims 1-31 were rejected as obvious in view of the combination of Ohler and Ogawa. Applicants respectfully request the Examiner to withdraw these rejections because the Ohler patent is not available as prior art to the present application for purposes of 35 U.S.C. §103.

The American Inventors Protection Act of 1999 amended 35 U.S.C. § 103 so that subject matter which is prior art under 35 U.S.C. § 103 via § 102(e) is now disqualified as prior art against a claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. The USPTO rules implementing this change in 35 U.S.C. § 103 state that:

The amendment of 103(c) "... shall apply to any application for patent filed on or after the date of enactment of this Act," which is November 29, 1999. Therefore, amended 103(c) will be applied to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d) and reissues.  
(See, MPEP 706.02(I)(1)).

Applicants point out that the Ohler patent and the present application, at the time the invention of the present application was made, were commonly owned. Therefore, due to the amendment of 35 U.S.C. § 103(c), the Ohler patent is not available as prior art against the claims of the present application. Accordingly, Applicants request that the rejection of Claims 1-31 under 35 U.S.C. § 103 be withdrawn.

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**Conclusion**

All the issues in the Office Action, dated March 30, 2004 have been addressed.  
Favorable consideration of the present application is requested. If any issues remain, the  
Examiner is invited to call the undersigned.

Respectfully submitted,



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